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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

MDE, A

ART UNIT

PAPER NUMBER

2612

DATE MAILED:

03/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/666,653

Applicant(s)

Honda et al.

Examiner

Aung S. Moe

Group Art Unit

2612



☒ Responsive to communication(s) filed on Dec 6, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 19-26 and 31-42 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 19-26 is/are allowed.

☒ Claim(s) 31-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on Dec 06, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/666,653 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. Claims 31-34, 35-38 and 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 31, it is unclear how “a still picture” recites in line 11 relates to “a still picture” recited in line 7? If there are the same “picture”, the Examiner suggests changing “a still picture” as recited in line 11 to **--said still picture--**.

In claim 31, it is unclear how “a moving picture” recites in line 12 relates to “a moving picture” recited in line 8? If there are the same “picture”, the Examiner suggests changing “a still picture” as recited in line 12 to **--said moving picture--**.

In claim 31, it is unclear how “ **a picture** to be reproduced as **a still picture** is recorded on the second recording medium” as recited in lines 9-10 relates to “**a picture** recorded on the second recording medium . . . as **a still picture** is reproduced,” as recited in lines 13-14? It is

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appeared that same "picture" is first recorded on *the second recording medium* and later reproduced for *the second recording medium*. If this assumption is correct, please change "a picture" and "a still picture" as recited in claim 31, lines 13 and 14 to **--said picture--** and **--said still picture--**.

As for claim 35, it is noted that claim 35 contains the similar problem as claim 31 as discussed above, thus, the Examiner suggests the following changes:

In claim 35, line 11, please change "a still picture" to **--said still picture--**;

In claim 35, line 12, please change "a moving picture" to **--said moving picture--**; and

In claim 35, line 13, please change "a still picture" to **--said still picture--**.

In claim 32, it is unclear how "a still picture recorded on the first recording medium" as recited in line 3 relates to "a still picture recorded on the first recording medium" as recited in claim 31, lines 11-12? If there are the same "still picture", the Examiner suggests changing "a still picture recorded on the first recording medium" as recited in claim 32, line 3 to-- **said still picture recorded on the first recording medium--**.

As for claim 36, it is noted that claim 36 has the same problem as claim 32 as discussed above, thus, the Examiner suggests changing "a still picture recorded on the first recording medium" as recited in claim 36, line 3 to-- **said still picture recorded on the first recording medium--**.

In claim 33, it is unclear how "a moving picture is recorded" as recited in line 2 relates to "a moving picture is recorded" as recited in claim 31, lines 8-9? If there are the same "moving

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picture”, the Examiner suggests changing “a moving picture recorded” as recited in claim 32, line 2 to-- **said** moving picture recorded--.

As for claim 37, it is noted that claim 37 contains the same problem as claim 33 as discussed above, thus, the Examiner suggests changing “a moving picture recorded” as recited in claim 32, line 2 to-- **said** moving picture recorded--.

As for claim 34, it is unclear how “a still picture”, “a moving picture” and “information” as recites in line 2 relates to “a still picture”, “a moving picture” and “information” as recited in claim 31, lines 7 and 8? If there are the same “a still picture”, “a moving picture” and “information”, the Examiner suggest changing “a still picture”, “a moving picture” and “information” as recited in claim 34, line 2 to --**said** still picture--, --**said** moving picture--, and --**said** information--.

As for claim 38, 40 and 42, it is noted that claims 38, 40 and 42 contain the same problem as claim 34, thus, the Examiner suggest changing “a still picture”, “a moving picture” and “information” as recited in line 2 of claims 38, 40 and 42 to --**said** still picture--, --**said** moving picture--, and --**said** information--.

As for claim 39, it is noted that claim 39 contains the similar problem as discussed above for claims 31-38, thus, thus, the Examiner suggests the following changes:

In claim 39, lines 7-8, please change “a moving picture” to --**said moving picture**--;

In claim 39, line 9, please change “a still picture” to --**said still picture**--; and

In claim 39, line 12, please change “a moving picture” to --**said moving picture**--.

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As for claim 41, it is noted that claim 41 contains the similar problem as discussed above for claims 31-40, thus, thus, the Examiner suggests the following changes:

In claim 41, line 7, please change "a moving picture" to **--said moving picture--**;

In claim 41, line 8, please change "a still picture" to **--said still picture--**; and

In claim 41, line 11, please change "a moving picture" to **--said moving picture--**.

As for claims 40 and 42, it is noted that claims 40 and 42 contain the same problem as claim 34, thus, the Examiner suggest changing "a still picture", "a moving picture" and "information" as recited in line 2 of claims 40 and 42 to **--said still picture--**, **--said moving picture--**, and **--said information--**.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 31-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that all the newly added independent claims 31, 35, 39 and 40 called for the limitations such that "a mode in which a still picture is reproduced out of a picture recorded

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as a moving picture on the second recording medium/recording medium", and such limitations are not clearly disclosed in the instant application.

If Applicants believe that such claimed limitations were disclosed in the instant Application in such *full, clear, concise, and exact terms as to enable any person skilled in the art*, it is respectfully requested that the Applicants specifically indicate where in the instant application disclosed those limitations of claims 31, 35, 39 and 40 as discussed above. However, for the purpose of examination, the Examiner is assuming that Applicants had possession of such claimed limitations and rejection on claims 31-42 are as follows:

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims ~~31-38~~^{31-32, 34-36, 38} are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue (U.S. 5,710,954).

Regarding claim 31, Inoue '954 discloses a photographing apparatus (*see Figs. 1, 12, 17 and 25*) comprising:

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a first recording section (*i.e., noted the use of a silver salt film*) for recording, on a first recording medium, mainly still pictures together with information relating to the still pictures thus recorded (*as shown in Figs. 4 and 9, it is noted that with the use of the magnetic recording circuit 13, the information relating to the still pictures recorded on the film may be recorded on a magnetic recording layer 51 of the film so that such information may be used when a still picture recorded on the film is printed; see col. 9, lines 30+ and col. 11, lines 40+*);

a second recording (*i.e., noted the use of Memory 111, 125 or 226*) section capable of recording, on a second recording medium, moving pictures and also pictures to be reproduced as still pictures; and

a mode selector for selecting among a plurality of shooting and reproducing modes (*i.e., noted that with the use of control unit 30, 123 or 237 and the input units, the user may select among a plurality of shooting and reproducing modes; see Figs. 2, 5, 8 and 14-16*), said shooting modes including a mode in which a still picture and information relating thereto are recorded on the first recording medium (*see Figs. 2 & 5, col. 11, lines 15+ and col. 26, lines 39+*), a mode in which a moving picture is recorded on the second recording medium, and a mode in which a picture to be reproduced as a still picture is recorded on the second recording medium (*i.e., noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory first, so that they may be reproduced to display on the display monitor; see Figs. 12, 14-17 and 20, the elements 111, 125 & col. 19, lines 30+ and col. 21, lines 25+*), said reproducing modes including a mode in which information

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relating to a still picture recorded on the first recording medium is displayed (*Figs. 7-9, col. 3, lines 4+, col. 12, lines 10+ and col. 13, lines 15+*), a mode in which a moving picture recorded on the second recording medium is reproduced (*col. 21, lines 25+*), a mode in which a picture recorded on the second recording medium so as to be reproduced as a still picture is reproduced (*Fig. 15, col 21, lines 25-68*), and a mode in which a still picture (*i.e., Figs. 19, 20 and 23, "STILL IMAGE" and noted the still image display in the sub-monitor*) is reproduced out of a picture recorded as a moving picture (*i.e., Figs. 19, 20 and 23, "MOVING IMAGE" and noted the moving image display on the main-monitor*) the second recording medium (*i.e., the memory device as shown in Figs. 12 & 17*).

Regarding claim 35, Inoue '954 discloses a photographing apparatus *see Figs. 1, 12, 17 and 25*) comprising:

a first recording section for recording (*i.e., noted the use of a silver salt film*), on a first recording medium, mainly still pictures together with information relating to the still pictures thus recorded (*as shown in Figs. 4 and 9, it is noted that with the use of the magnetic recording circuit 13, the information relating to the still pictures recorded on the film may be recorded on a magnetic recording layer 51 of the film so that such information may be used when a still picture recorded on the film is printed; see col. 9, lines 30+ and col. 11, lines 40+*);

a second recording section capable of recording (*i.e., noted the use of Memory 111, 125 or 226*), on a second recording medium, moving pictures and still pictures; and

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a mode selector for selecting among a plurality of shooting and reproducing modes (*i.e.*, *noted that with the use of control unit 30, 123 or 237 and the input units, the user may select among a plurality of shooting and reproducing modes: see Figs. 2, 5, 8 and 14-16*), said shooting modes including a mode in which a still picture and information relating thereto are recorded on the first recording medium (*see Figs. 2 & 5, col. 11, lines 15+ and col. 26, lines 39+*), a mode in which a moving picture is recorded on the second recording medium, and a mode in which a still picture recorded on the second recording medium (*i.e.*, *noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory first, so that they may be reproduced to display on the display monitor; see Figs. 12, 14-17 and 20, the elements 111, 125 & col. 19, lines 30+ and col. 21, lines 25+*), said reproducing modes including a mode in which information relating to a still picture recorded on the first recording medium is displayed (*Figs. 7-9, col. 3, lines 4+, col. 12, lines 10+ and col. 13, lines 15+*), a mode in which a moving picture recorded on the second recording medium is reproduced (*col. 21, lines 25+*), a mode in which a still picture recorded on the second recording medium is reproduced (*Fig. 15, col 21, lines 25-68*), and a mode in which a still picture (*i.e.*, *Figs. 19, 20 and 23, "STILL IMAGE" and noted the still image display in the sub-monitor*) is reproduced out of a picture recorded as a moving picture (*i.e.*, *Figs. 19, 20 and 23, "MOVING IMAGE" and noted the moving image display on the main-monitor*) the second recording medium (*i.e.*, *the memory device as shown in Figs. 12 & 17*).

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Regarding claims 32 and 36, Inoue '954 discloses wherein the information recorded on the first recording medium is information used when a still picture recorded on the first recording medium is printed (*col. 11, lines 30+ and col. 12, lines 5+ of Inoue '954*).

Regarding claims 34 and 38, Inoue '954 discloses wherein, a display for displaying a still picture, a moving picture, or information in any of the reproducing modes (*see Figs. 6-7, col. 3, lines 4+, col. 9, lines 7+, col. 12, lines 10+ of Inoue '954*).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '954 in view of Itoh et al (U.S. 5,528,433).

As for claims 33 and 37, Inoue '954 discloses that an aspect ratio of the picture can be varied for the still images with the use of the post-processing information input unit 27 (*Figs. 6-7, col. 12, lines 5+ of Inoue '954*), however, Inoue '954 does not explicitly shows wherein an aspect ratio of the moving picture can be varied as recited in claim 33 and 37.

Nevertheless, the above mentioned claimed limitations are well known in the art as evidenced by Itoh '433. In particular, Itoh '433 teaches that it is well-known to vary an aspect ratio of the recorded moving picture, for example, changing the aspect ratio from 16:9 to 4:3 (*see col. 3, lines 25+ and col. 4, lines 45+; Figs. 1 and 4A-4B*), so that both wide and normal picture signals may be displayed on the same display device and this provides convenient to users (*see col. 1, lines 30+*).

In view of the above, having the system of Inoue '954 and then given the well-established teaching of Itoh '433, it would have been obvious to one having ordinary skill in the art at the time invention was made to modify the system of Inoue '954 as taught by Itoh '433, since Itoh '433 suggests at col. 1, lines 30+ that such a modification would allow recording/reproducing both a wide picture signal and a normal picture signal may be displayed on the same display device, and this would further enhance ambience (*see col. 1, lines 15+ of Itoh '433*). Moreover, Itoh '433 further suggested that such modification is accordingly convenient to users because an

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aspect ratio of the reproduced video signal may be varied automatically during the reproducing operation (*see col. 1, lines 45+ of Itoh '433*).

9. Claims 39-40 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue '954 in view of Itoh et al (U.S. 5,528,433).

Regarding claim 39, Inoue '954 discloses a photographic apparatus (*see Figs. 1, 12, 17 and 25*) comprising:

a recording section capable of recording, on a recording medium (*i.e., noted the use of Memory 111, 125 or 226*), moving pictures and also pictures to be reproduced as still pictures (*col. 19, lines 30+ and col. 21, lines 55+*);

a mode selector for selecting among a plurality of shooting and a reproducing modes (*i.e., noted that with the use of control unit 30, 123 or 237 and the input units, the user may select among a plurality of shooting and reproducing modes; see Figs. 2, 5, 8 and 14-16*), said shooting modes including a mode in which a moving picture is recorded on the recording medium and a mode in which a picture to be reproduced as a still picture is recorded on the recording medium (*i.e., noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory first, so that they may be reproduced to display on the display monitor; see Figs. 12, 14-17 and 20, the elements 111, 125 & col. 19, lines 30+ and col. 21, lines 25+*), said reproducing modes include a mode in which the moving picture recorded on the recording medium is reproduced (*col. 21, lines 25+*), a mode in

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which a picture recorded on the recording medium so as to be reproduced as the still picture is reproduced (*Fig. 15, col 21, lines 25-68*), and a mode in which a still picture (*i.e., Figs. 19, 20 and 23, "STILL IMAGE" and noted the still image display in the sub-monitor*) is reproduced out of a picture recorded as a moving picture (*i.e., Figs. 19, 20 and 23, "MOVING IMAGE" and noted the moving image display on the main-monitor*) on the recording medium (*i.e., the memory device as shown in Figs. 12 & 17*); and

Regarding claim 41, Inoue '954 discloses a photographic apparatus (*see Figs. 1, 12, 17 and 25*) comprising:

a recording section capable of recording, on a recording medium (*i.e., noted the use of Memory 111, 125 or 226*), moving pictures and still pictures (*col. 19, lines 30+ and col. 21, lines 55+*);

a mode selector for selecting among a plurality of shooting and a reproducing modes (*i.e., noted that with the use of control unit 30, 123 or 237 and the input units, the user may select among a plurality of shooting and reproducing modes; see Figs. 2, 5, 8 and 14-16*), said shooting modes including a mode in which a moving picture is recorded on the recording medium and a mode in which a still picture is recorded on the recording medium (*i.e., noted that both still/moving image signals generated by the image pickup device and signal processing unit have to record on the image memory first, so that they may be reproduced to display on the display monitor; see Figs. 12, 14-17 and 20, the elements 111, 125 & col. 19, lines 30+ and col. 21, lines 25+*), said reproducing modes include a mode in which a moving picture recorded on the

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recording medium is reproduced (*col. 21, lines 25+*), a mode in which a still picture recorded on the recording medium is reproduced (*Fig. 15, col 21, lines 25-68*), and a mode in which a still picture (*i.e., Figs. 19, 20 and 23, "STILL IMAGE" and noted the still image display in the sub-monitor*) is reproduced out of a picture recorded as a moving picture (*i.e., Figs. 19, 20 and 23, "MOVING IMAGE" and noted the moving image display on the main-monitor*) on the recording medium (*i.e., the memory device as shown in Figs. 12 & 17*).

Furthermore, it noted that although Inoue '954 discloses that an aspect ratio of the picture can be varied for the still images with the use of the post-processing information input unit 27 (*Figs. 6-7, col. 12, lines 5+ of Inoue '954*), Inoue '954 does not explicitly shows wherein an aspect ratio of the moving picture can be varied as recited in claim 39 and 41.

Nevertheless, the above mentioned claimed limitations are well known in the art as evidenced by Itoh '433. In particular, Itoh '433 teaches that it is well-known to use an aspect ratio selector for varying an aspect ratio of the recorded moving picture, for example, changing the aspect ratio from 16:9 to 4:3 (*see col. 3, lines 25+ and col. 4, lines 45+; Figs. 1 and 4A-4B*), so that both wide and normal picture signals may be displayed on the same display device and this provides convenient to users (*see col. 1, lines 30+*).

In view of the above, having the system of Inoue '954 and then given the well-established teaching of Itoh '433, it would have been obvious to one having ordinary skill in the art at the time invention was made to modify the system of Inoue '954 as taught by Itoh '433, since Itoh '433 suggests at col. 1, lines 30+ that such a modification would allow recording/reproducing

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both a wide picture signal and a normal picture signal may be displayed on the same display device, and this would further enhance ambience (*see col. 1, lines 15+ of Itoh '433*). Moreover, Itoh '433 further suggested that such modification is accordingly convenient to users because an aspect ratio of the reproduced video signal may be varied automatically during the reproducing operation (*see col. 1, lines 45+ of Itoh '433*).

Regarding claims 40 and 42, Inoue '954 discloses wherein, a display for displaying a still picture, a moving picture, or information in any of the reproducing modes (*see Figs. 6-7, col. 3, lines 4+, col. 9, lines 7+, col. 12, lines 10+ of Inoue '954*).

10. Claims 19-26 are allowed for the reasons set forth in the previous Office action (please see paper no. 7 & 12).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Imaiida '369 teaches the apparatus and method for recording/reproducing a moving/still image on the recording medium and the aspect ratio selector for varying the aspect ratio of the image signals thereof.

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b. Ootsuka '754 shows the camera including a first recording means (i.e., film) for recording/reproducing a still image and second recording means (i.e., tape 52) for recording/reproducing a still image or motion image thereof.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Aung S. Moe** whose telephone number is **(703) 306-3021**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on (703) 305-4929.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

(703) 308-6306


or:

(703) 308-6296, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

A. Moe 

February 20, 2001


WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
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